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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,702	12/02/2004	Andreas A Popp	29827/40663	6743
4743	7590	10/18/2007		
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,702

Applicant(s)

POPP ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,10-16,18,21-23,27,29,30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10-16,18,21-23,27,29,30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the amendment filed August 1, 2007, claims 2, 3, 8, 9, 17, 19, 20, 24, 25, 28, 31 have been cancelled. Claims 1, 4-7, 10-16, 18, 21-23, 27, 29, 30, 32-34 are pending.
2. In view of the amendment filed August 1, 2007, the rejection of Claims 1, 4-8, 10-18, 21-23, 26, 27, 29, 30, 32-34 under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsui et al. (EP 0 777 287 A2).

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The invention of claims 1, 4-6 relates to an ester F of formula Ia, Ib, Ic, wherein AO is for each AO independently EO or PO, EO is O-CH₂-CH₂-,

PO is at each instance independently O-CH₂-CH(CH₃)- or O-CH(CH₃)-CH₂-

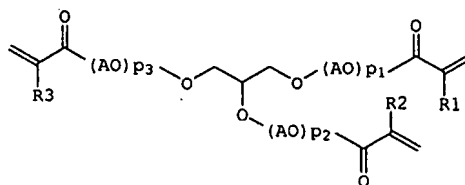
A sum of $m_1 + m_2 + m_3 + n_1 + n_2 + n_3$ is 3, 4, or 5,

A sum of $m_1 + m_2 + m_3$ is 1, 2, 3, or 4,

A sum of $p_1 + p_2 + p_3$ is 3, 4, or 5, and

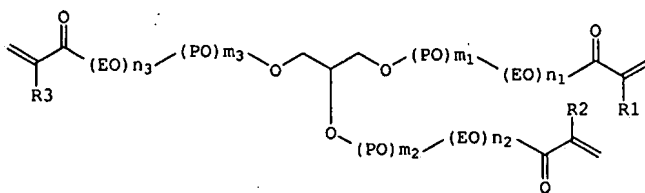
R₁, R₂, and R₃ are independently H or CH₃,

wherein at least one AO is PO and at least one further AO is EO.



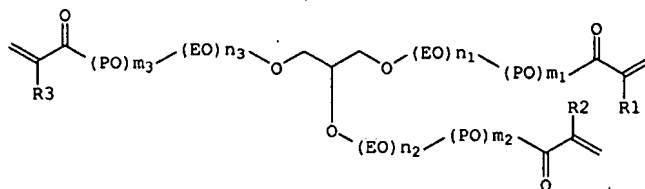
Ia

or formula Ib



Ib

or formula Ic



Ic

Matsui et al. (abstract) disclose formula (1-4), where m and n are greater or equal to zero, and m and n cannot be zero at the same time, that is fully encompassing the ester F as claimed. Claims 1, 4-6 are anticipated.

5. Claims 7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Barthold et al. (US 5,472,617).

The invention of claims 7, 8, 10 relates to a process for preparing an ester F of claim 1 from an alkoxyated glycerol of the formula IIa, IIb, or IIc, wherein AO, EO, PO, n1, n2, n3, m1, m2, m3, p1, p2L and p3 are each as defined in claim 1, and (meth)acrylic acid, comprising the steps of

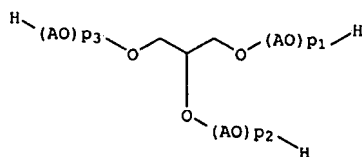
a) reacting the alkoxyated glycerol with the (meth)acrylic acid in the presence of at least one esterification catalyst C, at least one polymerization inhibitor D, and optionally a water-azeotroping solvent E to form the ester F,

b) optionally removing from the reaction mixture some or all of the water formed in a), during and/or after a),

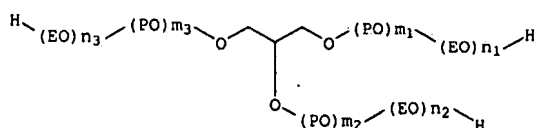
f) optionally neutralizing the reaction mixture,

h) when a solvent E is used, optionally removing the solvent E by distillation, and/or

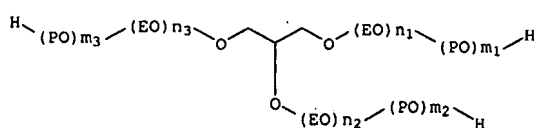
i) stripping with an oxygen-containing gas which is inert under the reaction conditions, wherein a molar excess of (meth)methacrylic acid present in the reaction mixture after the last process step substantially remains in the reaction mixture.



IIa



IIb



IIc

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Barthold et al. (col. 8, line 65 to col. 9, line 40; col. 9, Table 1; col. 11, Table 3) disclose a process for preparing the compound ester F as claimed. Regarding the claimed "stripping with a gas which is inert under the reaction conditions", since Barthold et al. col. 10, line 52 to col. 11, line 2) clearly disclose the stripping of water under a nitrogen atmosphere, the examiner has a reasonable basis that the claimed "stripping with a gas which is inert under the reaction conditions" has been met by Barthold et al.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barthold et al. (US 5,472,617).

Set forth from paragraph 7 of instant office action, the process of Barthold et al. is very similar to the process of claims 11-13.

The difference between the invention of claims 11-13 and Barthold et al. is that Barthold et al. do not disclose minor variations of the process as claimed.

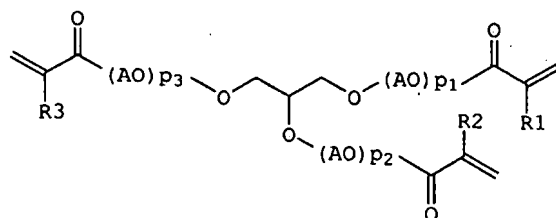
Nevertheless, Barthold et al. (col. 8, line 65 to col. 9, line 40; col. 9, Table 1; col. 11, Table 3) have clearly disclosed a process for preparing the compound ester F as claimed. Therefore, the examiner believes that it would have been obvious to one of ordinary skill in art to use "routine experimentation" technique to optimize the process of Barthold et al. to obtain the invention of claims 11-13. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

8. Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Barthold et al. (US 5,472,617).

The invention of claims 14-16 relates to a process for preparing a crosslinked hydrogel and product thereof, comprising the steps of

k) polymerizing an ester F of claim 1 or an ester F of the formula Ia

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Ia

wherein AO is for each AO independently EO or PO,

EO is O-CH₂-CH₂-,

PO is at each instance independently O-CH₂-CH(CH₃)- or O-CH(CH₃)-CH₂-

A sum of P₁ + p₂ + p₃ is 3, 4, or 5,

R₁, R₂, and R₃ are independently H or CH₃,

with (meth)acrylic acid, optionally an additional monoethylenically unsaturated compound N, and optionally one further copolymerizable hydrophilic monomer M, in the presence of at least one free-radical initiator K and optionally of at least one grafting base L,

l) postcrosslinking the reaction mixture obtained from k),

m) drying the reaction mixture obtained from k) or i), and

n) grinding and/or sieving the reaction mixture obtained from k), l), or m).

Barthold et al. (col. 8, line 65 to col. 9, line 40; col. 9, Table 1; col. 11, Table 3) disclose a process for preparing the compound ester F as claimed. Further, Barthold et al. (col. 13, Table 4; col. 16-17, claim 1) clearly teach the copolymerization of the prepared compound with a methacrylic acid or acrylic acid. Barthold et al. contain all the limitations of claims 14-16. Therefore, Claims 14-16 are anticipated.

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9. Claims 18, 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by Barthold et al. (US 5,472,617).

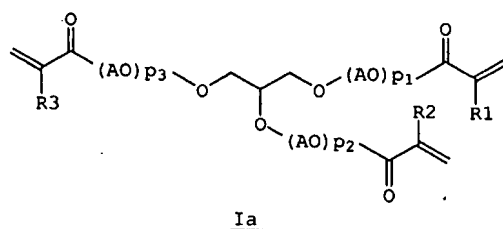
The invention of claims 18 relates to a crosslinked hydrogel comprising at least one hydrophilic monomer M in polymerized form crosslinked with an ester F of claim 1 or an ester F of formula Ia, wherein AO is for each AO independently EO or PO,

EO is O-CH₂-CH₂-,

PO is at east instance independently O-CH₂-CH(CH₃)- or O-CH(CH₃)-CH₂-

A sum of p₁+ p₂ + p₃ is 3 or 4

R₁, R₂, and R₃ are independently H or CH₃.



The invention of claim 21-23 relates to a composition comprising from 0.1% to 40% by weight of at least one ester F of claim 1 or an ester F of formula Ia, wherein AO is for each AO independently EO or PO,

EO is O-CH₂-CH₂-

A sum of p₁ + p₂ + p₃ is 3 or 4

R₁, R₂, and R₃ are independently H or CH₃, and (meth)acrylic acid,

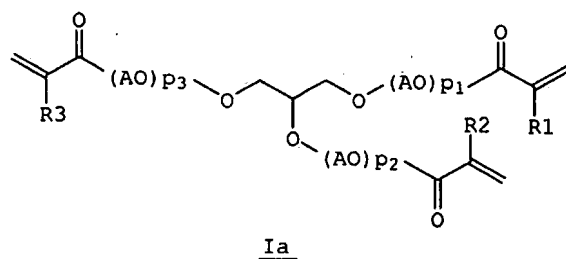
0.5-99.9% by weight of at least one hydrophilic monomer M,

0-10% by weight of at least one esterification catalyst C,

0-5% by weight of at least one polymerization inhibitor D, and

0-10% by weight of a solvent E,

with the proviso that the sum total is always 100% by weight.



Barthold et al. (col. 8, line 65 to col. 9, line 40; col. 9, Table 1; col. 11, Table 3) disclose a process for preparing the compound ester F as claimed. Further, Barthold et al. (col. 13, Table 4; col. 16-17, claim 1) clearly teach the copolymerization of the prepared compound with a methacrylic acid or acrylic acid. Barthold et al.

Although the main teachings of Barthold et al. is prepared a resin as oil demulsifiers for the rapid dehydration of crude oil (col. 1, line 10-15), Barthold et al. (col. 1, line 52-62) teach that all these disclosed resin can be easily gelled. Since Barthold et al. (col. 18, claims 6, 10) disclose that the composition can comprise water ranging from 1 to 99 %, the examiner has a reasonable basis that the claimed "diluent" has been met by Barthold et al. Further, since the composition of Barthold et al. can be in the form of a gel and contain water, the examiner has a reasonable basis that the claimed hydrogel feature has been met by Barthold et al.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 26, 27, 29, 30, 32-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barthold et al. (US 5,472,617).

The invention of claims 26, 27, 29, 30, 32-34 relates to a polymer prepared by the process of claim 14.

Barthold et al. (col. 8, line 65 to col. 9, line 40; col. 9, Table 1; col. 11, Table 3) disclose a process for preparing the compound ester F as claimed. Further, Barthold et

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al. (col. 13, Table 4; col. 16-17, claim 1) clearly teach the copolymerization of the prepared compound with a methacrylic acid or acrylic acid. Barthold et al.

Although the main teachings of Barthold et al. is prepared a resin as oil demulsifiers for the rapid dehydration of crude oil (col. 1, line 10-15), Barthold et al. (col. 1, line 52-62) teach that all these disclosed resin can be easily gelled. Since Barthold et al. (col. 18, claims 6, 10) disclose that the composition can comprise water ranging from 1 to 99 %, the examiner has a reasonable basis that the claimed "diluent" has been met by Barthold et al. Further, since the composition of Barthold et al. can be in the form of a gel and contain water, the examiner has a reasonable basis that the claimed hydrogel feature has been met by Barthold et al.

Regarding the claimed saponification indexes, in view of the substantially identical composition of Barthod et al. and the composition as claimed, the examiner has a reasonable basis that the claimed saponification indexes are inherently possessed in Barthold et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William K. Cheung, Ph. D.

Primary Examiner

October 14, 2007

WILLIAM K. CHEUNG
PRIMARY EXAMINER